

### **REMARKS**

Applicants' representative thanks the Examiner for the courtesies extended during the phone conference on October 31, 2008, with Francis Dunn. During the phone conference, there was discussion of the rejection of certain claims, including claims 1 and 20, under 35 U.S.C. § 112. It was proposed that amendments be made to independent claim 1 to recite a microprocessor and an application program, the application program is recorded on a computer-readable medium and capable of execution by a computer, the application program comprising: an annotation management component and a navigation component with respective functionality as recited in claim 1; and independent claim 20 to recite a microprocessor and to delete language related to a computer-readable medium. The Examiner indicated that the proposed amendments could overcome the rejection under 35 U.S.C. § 112. There also was discussion regarding claims 14-19.

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1 and 20 have been amended as shown on pages 2-5 of the Reply. No new matter has been added.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Allowable Subject Matter**

Applicants' representative thanks the Examiner for indicating that claims 14-19 stand allowed, and claims 1-13 and 20 would be allowable if amended to overcome the rejection under 35 U.S.C § 112. (It should be noted that in the substantive discussion in the Office Action dated September 4, 2008, the Examiner indicated that claims 14-19 stand allowed; however, in the Office Action Summary of the Office Action dated September 4, 2008, the Examiner did not indicate that claims 14-19 stand allowed.)

#### **II. Rejection of Claims 1-13 and 20 Under 35 U.S.C § 112**

Claims 1-13 and 20 stand rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the enablement requirement. It is requested that the rejection of claims 1-13 and 20 be rejected for at least the following reason. Claims 1-13 and 20 contain a written description of the invention, and the manner and process of making it and using it, in such full, clear, concise,

and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and sets forth the best mode contemplated by the inventors for carrying out the subject innovation. 35 U.S.C § 112, first paragraph, provides:

The specification shall contain a written description of the invention, and the manner and process of making it and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Independent claim 1, as amended, recites: *[a] computer system that facilitates free form digital inking, comprising: a microprocessor and an application program, the application program is recorded on a computer-readable medium and capable of execution by a computer, the application program comprising: an annotation management component that generates a zoom window comprising an inking region for a digital document; and a navigation component that manually and automatically re-positions and re-sizes the zoom window and the inking region relative to the digital document, the re-position and re-size of the zoom window and the inking region occurs at least as an annotation of the digital document is entered in the inking region during an annotation event based at least in part on an amount of annotation information entered and displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.*

The claimed subject matter is a *computer system* that facilitates free form digital inking. The claimed subject matter comprises a *microprocessor* and an *application program*. The application program *is recorded on a computer-readable medium and capable of execution by a computer*, and comprises an *annotation management component* and a *navigation component* that are employed to facilitate free form digital inking of digital documents.

The claimed subject matter is in accordance with 35 U.S.C § 112, first paragraph, as the specification contains a written description of the subject innovation and manner and process of making it and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the subject innovation and sets forth the best mode contemplated by the inventors of carrying out their invention.

Further, independent claim 20, as amended, recites: *[a] computer system that facilitates electronic document annotating, comprising: a **microprocessor**; means for generating an annotation window comprising an inking region for an electronic document; means for defining a location of the annotation window; means for magnifying contents of the annotation window; means for employing the annotation window to annotate the electronic document; and means for manual and automatic re-positioning and re-sizing of the annotation window and the inking region relative to the electronic document, the re-positioning and re-sizing of the annotation window and the inking region occurs at least as an annotation of the electronic document is entered in the inking region during an annotation event based at least in part on a quantity of annotation information entered and displayed in the inking region, wherein size of the annotation window corresponds to size of the inking region.*

For at least reasons similar to the reasons stated herein with regard to independent claim 1, independent claim 20 is in accordance with 35 U.S.C § 112, first paragraph. For instance, the claimed subject matter is a **computer system** that facilitates annotating electronic documents. The claimed subject matter contains a **microprocessor**, which can be employed to facilitate annotating electronic documents. To facilitate annotating electronic documents, the claimed subject matter can *manually and automatically re-position and re-size an annotation window and inking region relative to the electronic document*, while the annotation is being entered in the inking region.

In view of at least the foregoing, the subject claims, independent claims 1 and 20 (and associated dependent claims 2-13) are in accordance with 35 U.S.C. § 112, first paragraph. Therefore, it is believed that the subject claims are in condition for allowance, and withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 1-13 and 20 Under 35 U.S.C § 112**

Claims 1-13 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is requested that this rejection be withdrawn for at least the following reason. The subject claims particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

35 U.S.C. § 112, second paragraph, provides: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

For at least reasons similar to the reasons stated herein with regard to the rejection of claims 1-13 and 20 under 35 U.S.C § 112, first paragraph, it is believed that the claimed subject matter particularly points out and distinctly claims the subject matter which the applicants regard as their invention and is in accordance with 35 U.S.C § 112, second paragraph.

For instance, the claimed subject matter, as recited in claim 1, is a *computer system* that facilitates free form digital inking. The claimed subject matter comprises a *microprocessor* and an *application program*. The application program *is recorded on a computer-readable medium and capable of execution by a computer*, and comprises an *annotation management component* and a *navigation component* that are employed to facilitate free form digital inking of digital documents.

Based on at least the foregoing, it is respectfully submitted that independent claims 1 and 20 (and associated dependent claims 2-13) are in condition for allowance, and the rejection of claims 1-13 and 20 should be withdrawn.

### **IV. Response to Potential Argument of the Examiner regarding Claims 14-19**

In anticipation of potential arguments of the Examiner with regard to claims 14-19, it is respectfully submitted that claims 14-19 in accordance with 35 U.S.C. § 101 and are allowable. The claimed subject matter, as recited in claims 14-19, produces a useful, concrete, and tangible result and is therefore within the bounds of statutory subject matter in accordance with 35 U.S.C. § 101. In determining patentability under 35 U.S.C. § 101, the machine-or-transformation test can be applied.

“The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70.” *In re Bilski*, \_\_ F.3d \_\_, 2007-1130, p. 24 (Fed. Cir. October 30, 2008).

The claimed subject matter satisfies the machine-or-transformation test and is in accordance with 35 U.S.C. § 101.

Independent claim 14 recites: *[a] computer-implemented method that provides a zoom window to annotate digital documents with digital ink, comprising: generating the zoom window comprising an inking region to facilitate initiating an annotation event; scaling contents displayed in the zoom window; manually and automatically re-positioning and re-sizing the zoom window and the inking region relative to at least one digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs at least as annotation of the at least one digital document is entered in the inking region during the annotation event as a function of an amount of annotation information entered and displayed in the inking region, wherein size of the zoom window corresponds to size of the inking region; positioning the zoom window over an area of interest; navigating the zoom window after annotating the at least one digital document; and terminating the annotation event after the annotation information is entered in the inking region.*

The claimed subject matter transforms an article into a different state or thing. In an aspect, the claimed subject matter is a computer-implemented method that provides a zoom window to annotate digital documents with digital ink. The claimed subject matter can generate a zoom window and can *scale contents* displayed in the zoom window – thus, content can be *transformed* in scale, which causes the content to be in a *different state*. The claimed subject matter also can *manually and automatically re-position and re-size the zoom window and inking region* relative to a digital document – thus, the zoom window can be *transformed* to a *different state* – as the zoom window is changed in size and moved in relation to a digital document. (See *Bilski*, \_\_ F.3d \_\_, 2007-1130, at p. 26 (electronic transformation of data into a visual depiction is sufficient to satisfy the transformation prong of the machine-or-transformation test).) Further, the claimed subject matter is *implemented* by a *computer*, and is therefore tied to a machine (e.g., a computer), which satisfies the “machine” prong of the machine-or-transformation test. Moreover, the claimed subject matter produces a useful, concrete, and

tangible result, as the claimed subject matter is a method that facilitates annotating digital documents with digital ink.

In view of at least the foregoing, the subject claims, claims 14-19 are in accordance with 35 U.S.C. § 101. Therefore, it is believed that the subject claims are in condition for allowance.

### CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP  
127 Public Square  
57<sup>th</sup> Floor, Key Tower  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731